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EXAMINER	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/786,404	SHIBASAKI ET AL.	
	Examiner	Art Unit	
	MELVIN H. POLLACK	2145	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 June 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-26* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-26* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *24 February 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *4/25/08*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☒ Other: *see attached office action*.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 27 June 2008 have been fully considered but they are not persuasive. An analysis of the arguments is provided below.

2. The title is still objected to, and an updated argument is provided below.

3. The 112 rejection has been withdrawn in light of the amendment and remarks, particularly Pp. 14-15 of the remarks.

4. Applicant argues that examiner requires more detailed description (P. 17). While the examiner disagrees with the applicant's asserted requirement of specificity, examiner hereby maps out the claims to advance prosecution. In the meantime, the applicant is reminded that the rejection is based on the art as a whole, and not solely on what the examiner argues.

5. Applicant argues that Maher teaches digital rights management (DRM) but does not expressly disclose copyright protection (Pp. 17-18). While it is true that Maher does not expressly use the term copyright, DRM is well known in the art as the primary method of copyright protection in digital media. Maher's goal is further to protect the interests of content owners and to ensure the integrity of electronic transactions (col. 1, lines 30-50). It is further clear by other examples that Maher's credential system is used to protect copyright information (col. 3, line 45 - col. 4, line 55; col. 8, lines 25-55).

6. Regarding claim 12 (and the now fully modified claim 1), applicant argues that Maher does not expressly teach an "information-recording apparatus (P. 18)." As the term is no longer used, examiner presumes this term to mean the "information-recording device," and further determines this to be a client device that will receive the content information and record it onto a

medium, i.e. a CD-Rom as shown in Fig. 9. For example, content may be copied from the memory of a desktop client to the memory of a portable music player if and only if a remote server validates the credential (col. 8, lines 20-45).

7. Regarding claim 3, applicant argues that Maher does not expressly disclose trial information (P. 19). Maher teaches that there are flexible models for information sharing including which information can be shared and in what manner and this inherently includes the transmission of content samples, as previously cited. In the alternative, trial information may be interpreted as signing up for a membership, which Maher also teaches (col. 11, lines 45-55).

8. Regarding claim 6, Applicant argues that examiner does not show that cost information is taken into account in the correct manner (P. 19).

9. In response to applicant's argument that Maher's cost information is different, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

10. Applicant is also reminded that the difference between buying music and buying medical information is drawn to non-patentable subject matter. This descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see Cf. In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Merely labeling the data differently from that in the prior art would have been obvious matter of design choice. *See In re Kuhle*, 526 F.2d 553, 555, 188 USPQ 7, 9 (CCPA 1975).

11. That said, some discussion of Maher is required. The purpose of Maher is to facilitate the purchase of media content, i.e. movies songs and books, such that the content owner's interests are "represented." (Read: they get their money). In this way, the credentials also operate as cost information, defined as information regarding what the user paid for (the claims do not specify billing at the moment of request). Further, it is clear that the system is meant to allow for the purchase of music (col. 16, line 55 - col. 17, line 40).

12. Therefore, the rejection is maintained for the reasons above. This action is final.

Specification

13. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

14. The following title is suggested: Method of Checking Media Copyright before Downloading and Recording Content.

Claim Rejections - 35 USC § 102

15. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

16. Claims 1-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Maher et al. (7,213,266).

17. For claims 1, 12, 17, 23, 25, Maher teaches a system and an information-recording apparatus (abstract) that is capable of accessing an information-providing apparatus via a network (col. 1, line 1 – col. 3, line 45), and comprising:

a. an ID-information-acquisition device (Fig. 1, #112) which acquires ID information (col. 3, line 45 – col. 4, line 25) that corresponds to a media data recorded on a first recording medium (Fig. 9);

b. a protection-information-recognition device (Fig. 1, #102) adapted to recognize whether a first recording medium has protection information used for protecting copyright by restricting recording of media data from said first recording medium onto a second recording medium (col. 4, lines 25-55);

c. an ID-information-sending device (Fig. 1, #106) which sends ID-information corresponding to said media data to an information-providing apparatus via said network when said protection information is recognized (col. 13, line 50 – col. 16, line 55);

d. a corresponding-information-receiving device which receives corresponding content information related to said media data that is sent from said information-providing apparatus via said network according to said ID information (col. 5, line 25 – col. 7, line 25); and

e. an information-recording device which records said corresponding content information related to said media data onto said second recording medium (col. 10, lines 30-55).

18. For claim 2, Maher teaches that when recording media data onto said second recording medium, said information-recording apparatus records said corresponding content information related to said media data on to said other recording medium instead of said media data by way of said ID-information-sending device and said corresponding-information-receiving device when it is not possible to record said media data from said first recording medium to said second

recording medium regardless of whether or not there is said protection information (col. 4, lines 25-55).

19. For claims 3, 13, 18, 24, Maher teaches that said information-recording apparatus further comprises:

a. a trial-information-receiving device which receives trial information that is related to said media data and that is sent from said information-providing apparatus according to said ID information via said network (col. 7, line 25 – col. 8, line 15);

b. an information-reproduction device which reproduces said received trial information (Fig. 9); and

c. a corresponding-information-request device which prompts the user to request said corresponding content information related to said media data after said trial information has been reproduced by said information-reproduction device (col. 16, line 55 – col. 17, line 40); and wherein said information-providing apparatus further comprises:

d. a trial-information-acquisition device which acquires said trial information based on said ID information (Fig. 3A); and

e. a trial-information-sending device which sends said trial information to said information- recording apparatus via said network (col. 5, line 25 – col. 7, line 25); and

f. wherein said corresponding-information-sending device sends said corresponding content information related to said media data to said information-recording apparatus only when there was a request from said information-recording apparatus for said corresponding content information related to said media data (Fig. 3A).

20. For claims 4, 14, 19, Maher teaches that said information- recording apparatus further comprises:

a. a user-information-acquisition device which acquires user information that is set for each apparatus or for each said recording medium (col. 9, lines 5-55); and

b. a user-information-sending device which sends said acquired user information to said information-providing apparatus via said network (col. 9, line 55 – col. 10, line 30); and

c. wherein said information-providing apparatus further comprises a user-information- receiving device for receiving said user information sent from said information-recording apparatus (col. 11, lines 55-67); and

d. wherein said corresponding-information-sending device determines based on said user information whether or not access is improper access, and when it determines that access is improper access, it does not send said corresponding content information related to said media data to said information-recording apparatus (col. 11, lines 45-55).

21. For claims 5, 15, 20, Maher teaches that said information-recording apparatus further comprises a cost-information-receiving device which receives the cost corresponding to said corresponding content information related to said media data via said network (col. 10, lines 30-65); and wherein said information-providing apparatus further comprises:

a. a cost-information-acquisition device which acquires said cost information (col. 10, lines 30-65); and

b. a cost-information-sending device which sends said acquired cost information to said information-recording apparatus via said network (col. 10, lines 30-65).

22. For claims 6, 16, 21, Maher teaches that said information- providing apparatus further comprises a user-information-management device which manages said user information; and wherein said cost-information-acquisition device acquires said cost information based on said user information managed by said user-information-management device (col. 10, lines 30-65).

23. For claim 7, Maher teaches that said information-recording apparatus further comprises a cost-information-supply device which supplies the user with said cost information; and wherein said corresponding-information-request device prompts the user to request said corresponding content information related to said media data after said cost information has been supplied to the user by said cost-information-supply device (col. 10, lines 30-65).

24. For claim 8, Maher teaches that said cost information is information showing the bill for said corresponding content information related to said media data (col. 10, lines 30-65).

25. For claims 9, 22, Maher teaches that said first recording medium is a removable-type recording medium that is owned by said user (Fig. 9).

26. For claim 10, Maher teaches that said information-recording device correlates said corresponding content information related to said media data with said ID information and records them on said second recording medium (col. 5, line 25 – col. 7, line 25).

27. For claim 11, said ID- information-sending device determines whether or not said corresponding content information related to said media data correlated with said ID information is recorded on said second recording medium, and when it is determined that it is recorded, it does not send said ID information (col. 5, line 25 – col. 7, line 25).

28. For claim 26, the media data is music data and the first recording medium is a compact disc (col. 10, lines 30-55).

Conclusion

29. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MELVIN H. POLLACK whose telephone number is (571)272-3887. The examiner can normally be reached on 8:00-4:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Cardone can be reached on (571) 272-3933. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. H. P./
Examiner, Art Unit 2145
07 October 2008

/Jason D Cardone/
Supervisory Patent Examiner, Art Unit 2445